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EXAMINER

AHMED, AFFAF

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 04/06/2010.
2. Claim 36 has been added.
3. Claims 1, 9-10, 13-17 and 27-29 have been canceled.
4. Claims 26 and 30-36 are currently pending and have been examined.

Response to Applicant's Arguments

5. Applicant's amendments and arguments filed on 04/06/2010 have been fully considered and discussed in the next section. Applicant is reminded that the claims must be given its broadest, reasonable interpretation.

6. Applicant has amended the drawing and labeled figures 1 and 2 as prior art. Therefore, the objection of the drawing is withdrawn.

7. With regard to claim 26, rejection under 35 U.S.C § 101:

- Applicant argues that "the step of: *placing an advertisement for a product or service on an advertisement medium is not a purely mental step, but rather requires an advertisement medium with an advertisement including a telephonic number and an identification code*".

Examiner respectfully disagrees. No where does the Office Action rejection (mailed on 01/06/2010) of claim 26, under 35 U.S.C § 101 stated that the above claimed feature is a purely mental step. The Office Action has clearly stated that claim 26, **is not tied** to (1) a particular machine or apparatus (2) transform a particular article into a different state or thing.

- Applicant argues that "the step of: *enabling a potential customer to place a telephone call by entering the telephonic number into a telecommunications network is not a purely mental step, but rather requires the entry of the telephonic number into a physical device, namely a telecommunications network*".

Examiner respectfully disagrees. As stated above, No where does the Office Action rejection (mailed on 01/06/2010) of claim 26, under 35 U.S.C § 101 stated that the above claimed feature is a purely mental step. The Office Action has clearly stated that claim 26, **is not tied** to (1) a particular machine or apparatus (2) transform a particular article into a different state or thing.

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Furthermore, A **telecommunications network** is a collection of terminals, links and nodes which connect together to enable telecommunication between users of the terminals. The Physical device is not part of the telecommunication network, but rather the physical device connects to the telecommunication network. Thus, the Examiner is unclear what Applicant is referring to when stating that the above claimed feature requires *the entry of the telephonic number into a physical device, namely a telecommunications network.*

- *based at least partly on bids made for routing the telephone call, selecting a particular one of the plurality of vendors and routing the telephone call through the telecommunications network to the particular one of the plurality of vendors. This is not a purely mental step, but rather requires that the telephone call to be routed through the telecommunications network to a vendor.*

Examiner respectfully disagrees. As stated above, No where does the Office Action rejection (mailed on 01/06/2010) of claim 26, under 35 U.S.C § 101 stated that the above claimed feature is a purely mental step. The Office Action has clearly stated that claim 26, **is not tied** to (1) a particular machine or apparatus (2) transform a particular article into a different state or thing. Placing the call and routing the call to the selected vendor **is not clearly tied** to a machine and/or performed by a computer.

- Applicant argues that “*since the preamble states that the invention is a method of For routing a telephone call placed in response to the advertisement, the steps in the body of the claim relating to routing the telephone call can not be considered insignificant extra solution.*”

Examiner respectfully disagrees. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

- Applicant argues that “*obtaining the identification code from the telecommunications network and using the identification code to update a database, which is accessible by the particular one of the plurality of vendors, in order to obtain performance information indicating the effectiveness of the advertisement*”.

Examiner respectfully disagrees. As stated above, No where does the Office Action rejection (mailed on 01/06/2010) of claim 26, under 35 U.S.C § 101 stated that the above claimed feature is a purely mental step. The Office Action has clearly stated that claim 26, **is not tied** to (1) a particular machine or apparatus (2) transform a particular article into a different state or thing.

Therefore, the rejection of claim 26 under 35 U.S.C § 101 is maintained.

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8. With regard to claims 30 and 36 rejection under 35 U.S.C § 101, Applicant's arguments are considered, but they are not persuasive. Claims 30 and 36 depend on claim 26, which has been rejected under 35 U.S.C § 101 for the reasons stated above.

9. Applicant argues that "the Examiner has offered no information in response to Applicant's request for guidance as to what needs to the claims to satisfy the requirements of 35 U.S.C § 101".

Examiner respectfully disagrees. The Office Action has clearly stated that claim 26, **is not tied** to (1) a particular machine or apparatus (2) transform a particular article into a different state or thing.

10. With regard to claim 26 rejection under 35 U.S.C § 103 (a):

- Applicant argues that *"Moore et al, do not teach based at least partly on bids made for routing the telephone call, selecting a particular one of the plurality of vendors. Moore et al merely teach that merchants can send messages offering goods for sale. Theses offers of goods are not bids for routing a telephone call"*.

Examiner respectfully disagrees. As per Applicant's specification "selecting one of said at least one vendor to produce the particular vendor of choice, wherein said particular vendor is selected based on a bidding factor, and wherein the bidding factor comprises a bid made to a provider of said phone number (paragraph 131). where the bidding factor further comprises a preferred vendor status (based on a winning or weighted bid); wherein the bidding factor further comprises a geographical limiter; where the bidding factor further comprises availability of vendor in said category database; where the bidding factor further comprises a financial range provided by the customer; where the bidding factor further comprises a keyword distinction selected by said particular vendor (paragraph 132).

Moore in at least column 9, lines 33-63 and fig 5 with the associated text discloses an invention where a customer indicates his/ her desire to purchase a specific type, size and brand of TV for a specific price. Moore also in at least column 10, lines 13-17 discloses transaction which the merchant proposes (particular merchant form the plurality of merchants) may be exactly what the consumer has requested. Moore in at least column 10, lines 45-56 discloses that once the consumer has received an offer from a merchant, the consumer may wish to communicate further with the merchant for additional information -or additional bids- on the merchandise. Moore also in at least column 10, lines 57-62 discloses the message(s) are send to a central server, which in turn, **routes the** message (s) to the appropriate merchant (i.e. based on the wining merchant of specific bid).

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- Applicant argues that *"Moore does not teach routing the telephone call through the telecommunications network to the particular one of the plurality of vendors that was selected based at least partly on the bids"*.

Examiner respectfully disagrees. Moore in at least column 9, lines 33-63 and fig 5 with the associated text discloses an invention where a customer indicates his/ her desire to purchase a specific type, size and brand of TV for a specific price. The message of the desired item to be purchased by the customer goes to all merchants connected in the server of the local area through a telecommunication network. Moore also in at least column 10, lines 13-17 discloses the transaction which the merchant proposes (particular merchant from the plurality of merchants) may be exactly what the consumer has requested. Furthermore, Moore in at least column 10, lines 45-62 discloses once the consumer has received an offer from a merchant. The message (s) is send to the central server, which in turn, routes the message (s) to the appropriate merchant (winning merchant) through a telecommunication networks (fig 6 and fig 5 with the associated text).

- Applicant argues that *"Moore does not teach based at least partly on bids made for routing the telephone call, selecting a particular one of the plurality of vendors and routing the telephone call through the telecommunications network to the particular one of the plurality of vendors"*.

Examiner respectfully disagrees. Applicant's argument here is the same argument that the Examiner has addressed above.

- Applicant argues that *"Thornton teaches routing the call to a vendor based on the access number that the caller dialed and on the geographic location of the caller with respect to the geographic location of broker, agent, dealership, branch or store of the subscriber or vendor. Moore et al. do not teach anything related to any type of routing similar to that in Thornton"*.

The Examiner is unclear what Applicant's is referring to by *Moore et al. do not teach anything related to any type of routing similar to that in Thornton"*.

However, Moore in at least column Moore in at least column 9, lines 33-67 and column 10, lines 14-62 discloses routing messages through a telecommunication network; based on geographic location of a consumer with respect to the geographic location of a merchant using a cell phone as a communication device.

Further more, Moore's reference is used to address the limitations of: *based at least partly on bids made for routing the telephone call, selecting a particular one of the plurality of vendors and routing the telephone call through the telecommunications network to the particular one of the plurality of vendors and performing the step of selecting the particular one of the plurality of vendors based at least in part on a financial range provided by the potential customer.*

11. With regard to claims 31 and 32 rejection under 35 U.S.C § 103 (a):

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- Applicant argues that “*Val et al. do not teach or suggest using an identification code in an advertisement to select one of a plurality of vendors and to then route a telephone call to the selected vendor*”.

Examiner respectfully disagrees. The above limitation is addressed under Thornton's reference (column 8, lines 56-65).

Further more; Val's reference is used to address the limitation of: *using the identification code to identify a geographic location*.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

13. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

14. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 26, 30-35 provisionally rejected on the ground of nonstatutory double patenting over claims 17-19 of copending Application No. 11/164084. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. Claim 17 of the co-pending application recites the limitation of: *accessing performance data, said performance data related to said at least one search engine; determining the relative cost of said advertising channel for at least one product; and providing a price target for acquisition of said advertisement*. It would have

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been obvious to one of ordinary skill in the art at the time of the invention to include in the instant application accessing performance data, said performance data related to said at least one search engine and determining the relative cost of said advertising channel for at least one product; and providing a price target for acquisition of said advertisement with the motivation of correctly billing advertisers based on paid –placement performance.

16. Claims 26, 30-35 provisionally rejected on the ground of nonstatutory double patenting over claims 1-11 of copending Application No. 11/877639. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. Claims 1 and 10 of the co-pending application recite the limitations of: *wherein said customer makes said customer call by dialing said phone and entering one of said plurality of consumer category codes, determining which of said plurality of consumer category codes is entered by said customer; associating said customer call with a consumer category based on which of said plurality of consumer category codes is entered and creating a consumer category database, wherein said consumer category database contains at least one vendor related with said consumer category.* It would have been obvious to one of ordinary skill in the art at the time of the invention to include *entering one of said plurality of consumer category codes, determining which of said plurality of consumer category codes is entered by said customer; associating said customer call with a consumer category based on which of said plurality of consumer category codes is entered and creating a consumer category database, wherein said consumer category database contains at least one vendor related with said consumer category* with the motivation of keeping track of particular category and/or particular advertisement effectiveness.

17. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: advertising of a telephonic number for a product or service to be sold, where the advertisement includes an identifier for tracking performance of the advertisement.

18. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

19. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Claim Rejections - 35 USC § 101

20. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

21. Claim 26 and its dependent claims are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

Here, claim 26 does not transform underlying subject matter and the claim is not tied to a particular machine. Examiner notes the disclosure of *routing the telephone call through a telecommunication network, however routing the telephone call through a telecommunication network* is considered insignificant extra solution activity and can not provide the basis for patentability under 101 *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008). Accordingly claim 26 is rejected.

Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. Claims 26, 30 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton, US Pat No: 6,097,792 in view of Moore, US Pat No: 7,200,566 B1.

Claims 26, 33 and 36:

Thornton discloses:

- *placing an advertisement for a product or service on an advertisement medium , the advertisement including a telephonic number for contacting a vendor in order to obtain the product or service (see at least column 8, lines 46-49);*
- *enabling a potential customer to place a telephone call by entering the telephonic number into a telecommunications network (see at least column 7, lines 1-10, column 8, lines 36-52 and Fig 4 with the associated text);*
- *obtaining the identification code from the telecommunications network and using the identification code to update a database, which is accessible by the particular one of the plurality of vendors, in order to obtain performance information indicating the effectiveness of the advertisement (see at least column 10, lines 1-16, column 11, lines 14-42 and column 17, lines 19-29);*

Thornton does not specifically disclose, but Moore however discloses:

- *based at least partly on bids made for routing the telephone call, selecting a particular one of the plurality of vendors and routing the telephone call through the telecommunications network to the particular one of the plurality of vendors (see at least column 9, lines 65-67 and column 10, lines 1-12);*
- *performing the step of selecting the particular one of the plurality of vendors based at least in part on a financial range provided by the potential customer (see at least column 9, lines 32-67 and column 10, lines 1-12) ;*

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the telephonic interactive leads system and method of Thornton the ability to allow bids made for routing the telephone call through the telecommunications network to

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the particular one of the plurality of vendors and selecting a particular one of the plurality of vendors as taught by Moore, since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results (providing vendors with bargaining opportunity to meet consumers' needs) of the combination were predictable.

Claim 30:

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

wherein the potential customer places the telephone call by entering the telephonic number into a keypad of a telephone communicating with the telecommunications network; and the potential customer enters the identification code into the telecommunications network by entering the identification code into the keypad of the telephone communicating with the telecommunications network (see at least column 8, lines 53-67 and column 9, lines 1-4);

Claim 34:

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

- *wherein the identification code is a consumer category code associated with the plurality of vendors (see at least column 8, lines 24-64, fig 3 and fig 4 with the associated text);*

Claim 35:

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

- *performing the step of selecting the particular one of a plurality of vendors and routing the telephone call to the particular one of the plurality of vendors based on the identification code that is included in the advertisement (see at least column 8, lines 24-35 and fig 3 with the associated text);*

25. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton, US Pat No: 6,097,792 in view of Moore, US Pat No: 7,200,566 B1 in view of Val et al, US Pat No: 6,898,571.

Claims 31 and 32:

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

- *associating the identification code with a plurality of vendors* (see at least column 8, lines 24-64, fig 3 and fig 4 with the associated text);
- *performing the step of selecting the particular one of the plurality of vendors and routing the call to the particular one of the vendors using the identification code* (see at least column 8, lines 56-65);

The combination of Thornton/Val disclose:

- *using the identification code to identify a geographic location;*

Thornton in at least column 8, lines 53-64 discloses an embodiment, where the ID extension numbers could be used to identify particular categories of home and cars, for example, (grouped by price range of particular characteristics rather than identifying a single home or car. Thornton also in at least column 15, lines 9-41 discloses call redirection that utilizes the call routing database and can be utilized in many ways. For example, it could be used to reroute the phone call to the sponsor of the DNI, particular brokers or agents, car dealerships, or to the branch of real estate office closest to the caller's home utilizing the already captured ANI and reverse match address information.

Val in at least column 1, lines 39-42 discloses an embodiment where an advertiser advertises a product or service in the usual manner except that alpha numeric code is identified in the advertisement. The consumer, desiring additional information regarding the advertisement, uses the Internet to log onto a particular website common to all advertisers and then enters the code for the ad. The particular code then accesses an enhanced ad that specifically directed to a particular geographic location or otherwise customized for the particular customer. Val also in at least column 2, lines 48-58 discloses the advertiser prepares a set of one or more enhancement for each product. The enhancement shows the appropriate information for a given product (s). The enhancement target different regions and consumers preferences. For example the geographic regions may be divided into countries, states or regions so as to provide consumers the information consumer needs to purchase a product.

It would have been obvious to none of ordinary skill in the art at the time of the invention to include interactive method and system for the generation of leads of Thornton/ Moore the ability in the advertisement code to identify a geographic limit as taught by Val, since the claimed invention is merely a combination of old elements, and in the combination

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each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results (providing consumers with the appropriate services) of the combination were predictable.

Conclusion

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX Months from the mailing date of this final.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/
Primary Examiner, Art Unit 3622